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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,830	12/30/1999	RICHARD NORRIS DODGE II	11710-0111	6932

23594 7590 02/26/2003

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EXAMINER

PRATT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/475,830

Applicant(s)

DODGE II ET AL.

Examiner

Christopher C Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendments and accompanying remarks filed 4/10/00 have been entered and carefully considered. Applicant's amendment is found to overcome the 112 indefinite rejection of claim 1. Despite this advance, the amendments are not found to patently distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 and 31-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1 and 32-33 require specific permeability properties. Applicant's specification teaches that various structures can be used in conjunction with the superabsorbent material. This disclosure leads the skilled artisan to the understanding that any of these structures, when used in conjunction with the claimed superabsorbent material, will inherently result in the claimed properties. However, Applicant states that the "absorbent composites of the present invention have unique and unexpected composite permeability's (p. 4, lines 8-9 of applicant's response of paper number 14)." Applicant further states that "the

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composites of the present invention have a much higher composite permeability than the prior art composites, but have a lower capacity (Id, lines 12-13).” The specification does not teach how to alter the inherent properties of a superabsorbent material in order to create a material having a higher permeability and lower capacity. Similarly, applicant’s specification does not describe any specific configurations of absorbent structures, which can achieve the claimed properties. Applicant’s disclosure is so vague and indefinite that it leaves the alleged invention in the realm of speculation requiring further experimentation in order to achieve the claimed properties.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-23 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that claims 1-23 and 31-33 fail to correspond in scope with that which applicant regard as the invention can be found in Paper No. 14 filed 11/26/02. In that paper, applicant has stated “since applicant’s absorbent structures utilize **only** superabsorbent materials and fibers (p. 5, line 18 of applicant’s response of paper number 14),” and this statement indicates that the invention is different from what is defined in the claims because the claims utilize the open language “comprising,” which allows for the inclusion of other materials.

6. Claims 1-23 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 33 are indefinite because claims merely setting forth physical characteristics desired in an article and not setting forth specific compositions, which would meet such characteristics are invalid as vague and indefinite because they cover any conceivable combination of ingredients, either presently existing or which might be discovered in the future, as set forth in the previous actions. Claims 1 and 33 would impart desired characteristics too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition and, in effect, recites compounds by what it is desired that they do rather than what they are. Ex parte Slob (PO BdApp) 157 USPQ 172.

Claim 1 merely recites that the absorbent structure contains fibers and any superabsorbent material. They do not recite the form the fibers should be disposed in, the structural relationship between the fibers and the superabsorbent, nor what materials the superabsorbent should be composed of. In fact, the claims leave open the possibility that the invention can only contain as few as two individual fibers and the absorbent structure may be in the form of any known structure or combination of structures. Similarly, claims 1 and 33 allow for the superabsorbent material to be any known composition or any possible composition, which may be created or discovered in the future.

Applicant argues that the specification teaches that the absorbent structure is not important and can be any number of materials. The specification does lists illustrative examples of a variety of structures "including but not limited to," wovens, nonwovens, films, and foams, but states that the invention is not limited to the recited structures.

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Therefore, the specification does not limit the metes and bounds of the claim. The claims, when read in light of the specification, do not allow for an accurate comparison with the prior art and also do not put the public on adequate notice of the scope of applicant's invention.

Claim 33 adds the limitations "body-side liner" and "outer cover." These terms do not further limit the metes and bounds of the claims because the words "liner" and "cover" are not limiting and can be any possible known materials.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-23 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman (6380465 and 5669894), Chen et al (6261679), Beihoffer et al (6235965), or Mukaida et al (5676660), as previously set forth.

Applicant argues that it is not clear whether the examiner is rejecting these claims using a combination of these references or whether the examiner is alleging that the claims are unpatentable under each reference individually. In response, the examiner refers applicant to the first sentence, second paragraph of the advisory action of paper number 11, wherein the examiner stated that the references are used individually.

Applicant argues Goldman teaches a higher AUL than the AUL claimed by applicant. Applicant appears to argue that Goldman teaches an AUL of 25.5, while applicant's claimed AUL is less than 25. However, Goldman teaches an AUL of "about" 23. Therefore, when measured at applicant's pressure, the variation included by the word "about" would result in an overlap between Goldman and applicant's claimed property.

Moreover, the examiner notes that claims require that the superabsorbent material, and not the superabsorbent composite structure, have a specified AUL. It is the examiner's position that the AUL of a superabsorbent composition is an inherent property of the particular composition. Goldman teaches the use of the same superabsorbent material claimed by applicant. Therefore, it is the examiner's position that the AUL of Goldman is inherently substantially equivalent to the AUL of applicants claimed invention.

Applicant argues that the instant invention achieves novel properties "since applicants absorbent structure utilizes **only** superabsorbent materials and fibers (p. 5, line 18 of applicant's response of paper number 14)." This argument is not commensurate in scope with the claims. The claimed subject matter is not limited to "only" fibers and superabsorbent. The examiner also notes that applicant previously argued that p. 10, lines 5-18 of the specification teaches that the absorbent material may be contained in a variety of different forms including foams, films and various fibrous structures (p. 2, lines 9-11 of applicant's response of paper number 14).

Applicant argues that Chen is silent with respect to a GBP value. Applicant argues that Chen does not possess this property because Chen uses foams. This argument is not commensurate in scope with the claim. The claims refer to the GBP value of the superabsorbent material. The claims do not refer to the properties of the absorbent composite.

The examiner also notes that applicant's specification teaches that foams are suitable for use in the invention.

Applicant argues that Beihoffer fails to teach the use of fibers. However, Beihoffer teaches the use of fibers in col. 11, lines 14-20.

Applicant argues that Beihoffer teaches the multi-component material, which results in a higher AUL. However, Beihoffer teaches an AUL within applicant's claimed range (table 9).

Applicant argues that Makaida fails to teach applicant's claimed AUL. However, Makaida teaches an AUL of 20 (col. 3, line 56).

Said rejection is maintained from the last action.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the



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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher C. Pratt  
February 24, 2003



CHERYL A. JUSKA  
PRIMARY EXAMINER